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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,094	04/17/2001	David A. Hughes	50P4001.01	7732

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MILLER PATENT SERVICES  
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EXAMINER
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DUNHAM, JASON B

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/836,094	HUGHES ET AL.	
	Examiner	Art Unit	
	Jason B. Dunham	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/29/2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/27/2004</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

S.O.C.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over digitalriver.com (Ref U, Paper 20040723), referred to as Digital River here after, in view of Kenner (U.S. Patent No. 6,421,725).**

Referring to claim 27. Digital River discloses a method for facilitating a transaction for purchasable content over an electronic network, the method comprising:

- Maintaining a first presence on the electronic network to which a consumer may connect (Digital River Clients Web Site);
- Transmitting a first page from the first network server to the consumer over the electronic network, the first page including information concerning the purchasable content, the purchasable content including both downloadable digital data and physical media containing at least one of digital and analog data (Digital River: pages 3 and 10).
- Allowing the consumer to browse the first web site on the electronic network to obtain information concerning the purchasable content including both

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downloadable digital data and physical media (Digital River Client Services Web Site);

- Receiving a command from the consumer over the electronic network indicating that the consumer has selected certain of the purchasable content and wishes the transaction for the selected purchasable content, wherein the selected purchasable content is displayed on the first page (Digital River: Page 3);
- Determining that the selected purchasable content includes the downloadable digital data (Digital River: Page 3);
- Digital River teaches all of the above, but does not expressly disclose a method wherein the first network server presents the consumer with the opportunity to purchase either physical media or downloadable digital data, but if the transaction involves purchase of downloadable digital that cannot be delivered by the first network server, then the consumer is linked to the second network server in order to carry out the transaction. Kenner discloses a method comprising:
  - wherein the first server is enabled to sell physical media, but is not enabled to download downloadable digital data;
  - automatically linking the consumer to a second network server that hosts a second web site on the electronic network in response to the command;
  - transmitting a second page from the second network server to the consumer over the electronic network;
  - wherein the second network server is capable of supplying the downloadable data, the second page including information concerning

how to complete the transaction for the selected purchasable content, and such that the consumer may complete the transaction for the selected purchasable content from the second network server, whereby, the first network server presents the consumer with the opportunity to purchase either physical media or downloadable digital data, but if the transaction involves purchase of downloadable digital that cannot be delivered by the first network server, then the consumer is linked to the second network server in order to carry out the transaction (Kenner: page 6, lines 53-63).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Digital River to use a second network server for downloading data, as taught by Kenner, to manage bandwidth requirements while downloading data (Kenner: page 1, lines 54-59).

**Claims 28-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Digital River/Kenner as applied to claim 27 above, and further in view of Fritsch (U.S. Patent No. 6,233,682).**

Referring to claims 28-34. The combination of Digital River and Kenner teach all of the above but do not expressly teach a method of displaying the first and second pages in separate windows and branded by separate entities. Fritsch discloses a method compromising:

- displaying the first page in a first window and the second page in a second window (Fritsch: Figures 1A, 1C, & 1E);

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- wherein the first and second windows are displayed simultaneously on a monitor displayed (Fritsch: Abstract);
- wherein the first window is branded by a first entity and the second window is branded by a second entity (Fritsch: Figures 1A & 1E);
- wherein the second window is activated when the second page is received by the consumer over the electronic network and the first window is not active when the second window is activated (Fritsch: column 4, lines 5-28);
- wherein the second window is closed when the transaction for the certain of the purchasable content is completed (Fritsch: column 4, lines 5-28);
- automatically linking the consumer to the first presence on the electronic network when the transaction for the certain of the purchasable content is complete (Fritsch: column 4, line 47 – column 5, line 9);
- automatically linking the consumer to a third presence on the electronic network when the transition for the certain of the purchasable content is complete (Fritsch: Figure 1D).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the methods of Digital River and Kenner to include the features noted above, as taught by Fritsch, to separate browsing of purchasable media from downloading and purchasing digital media (Fritsch: column 5, lines 3-6).

Referring to claim 35: Digital River discloses a method wherein the physical storage media includes at least one of optically readable media, magnetically readable media, and mechanically readable media (Page 4).

Referring to claim 36: Digital River discloses a method wherein the second page includes at least one of: registration inputs for registering the consumer; (ii) login inputs for permitting the consumer access to further portions of the second page; (iii) summary information including at least one of a list of the purchasable content selected by the consumer, and remittance information for the purchasable content selected by the consumer; and (iv) billing inputs for receiving information from the consumer concerning a remittance method (Page 17).

Referring to claim 37: Digital River and Kenner teach the above but do not expressly disclose a method wherein the summary information and the billing inputs are included on the further portions of the second page. Kenner discloses a method wherein the summary information and the billing inputs are included on the further portions of the second page (Fritsch: Figure 1E). It would have been obvious to one of ordinary skill in the art to modify the teachings of Digital River and Kenner to include the summary information and billing inputs on the further portions of the second page, as taught by Fritsch, to separate the purchase information from the area available for browsing.

Referring to claim 38: Digital River discloses a method wherein the electronic network compromises the Internet and the first and second presences compromise respective web sites thereon (Page 18,19).

Referring to claim 39. Digital River discloses a method wherein an entity associated with the first network server does not have custody of the downloadable digital data (Page 4, "Digital River provides each of the companies in this category with a link off of their web site to their very own software store.")

Referring to claim 40. Digital River discloses a method wherein an entity associated with the second network server has custody of the downloadable digital data (Page 10, "Digital River is the logical choice as an ESD provider because they offer a solid turnkey Web-commerce solution along with the most extensive database of downloadable software products available on the market.").

Referring to claims 41-51. Claims 41-51 are rejected under the same rationale as set forth in claims 27-40.

Referring to claims 52-63. Claims 52-63 are rejected under the same rationale as set forth in claims 27-40.

### ***Response to Arguments***

Applicant's arguments filed 10/29/2004 have been fully considered but they are not persuasive.

The provisional obviousness-type double patenting rejection over patent application number 09/836,632 has been overcome by the abandonment of application number 09/836,632.

The Attorney argues that Fritsch does not disclose, "...automatically linking the consumer to a second presence on the electronic network in response to the command



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such that a second page is transmitted from the second presence to the consumer over the electronic network.”

The examiner notes, Fritsch does disclose “...automatically linking the consumer to a second presence on the electronic network in response to the command such that a second page is transmitted from the second presence to the consumer over the electronic network.”

The Examiner further notes, FIG. 1A shows an illustration of the video display screen **10** as viewed by the PC user after connecting to the vendor's web site for distributing musical products. As shown in the figure, the web site display is divided into 2 portions (two presences): main portion (presence) **12** on the left side of the screen **10** contains fields for entering music-related search queries. For example, the PC user may search for desired songs by artist after entering the artist's name. The operation is carried out by various search engines for searching relational databases. Alternatively, the PC user may look for a song by title or album name. Furthermore, as shown in FIG. 1A, songs and/or albums attributed to different genres may be displayed on the screen in response to the PC user's selection. The right portion (presence) of the display screen is independently controlled from the left portion and includes the “Shopping List” heading, as well as the login procedure for PC users. In particular, when a PC user desires to purchase a song or album, she registers with the web site vendor using the on-line login procedure. The registration comprises entering the username and password to gain access to the web site vendor's products. When a new PC user logs in, she selects a username and password and then clicks on the “New User” software

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button on the screen. The new PC user is then requested to re-confirm the selected password by entering the password once more. If the password is properly re-confirmed, she is allowed to purchase CDs, download digital music, or make other purchases from the web site.

The Attorney notes that the current claims find their basis in the 09/836,632 application, but have been substantially rewritten for presentation in the present application. The Attorney further notes that the claims call for the user to have the ability to shop for both downloadable and physical media from the first server and the user is only transferred to a second web page from a second server upon indication that downloadable content is specified for purchase. The Applicant submits that the Digital River reference is far from enabling as to Applicant's invention as claimed.

The examiner notes that the Digital River reference does enable the user the ability to shop for both downloadable and physical media from the first server. Kenner further teaches that it is known to transfer the user to a second presence only for the purpose of downloading downloadable content. The examiner further notes that the Digital River, Kenner, and Fritsch references are enabling and disclose each and every element of the claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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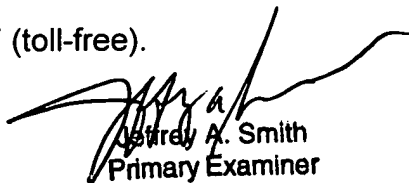
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JBD



Jeffrey A. Smith  
Primary Examiner